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3525-71

PTO/SB/121 (10-00)

Approved for use through 10/31/2002. OMB 0651-0035

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in the following listed application(s) or patent(s):

Patent Number (if appropriate)	Application Number	Patent Date (if appropriate)	U.S. Filing Date
	09/509,032		March 21, 2000
<div>RECEIVED JUN 06 2003 TECH CENTER 1600/2900</div>			

Typed or  
Printed Name

Leonard C. Mitchard

Signature

Date

June 5, 2003

Address of signer:

1100 North Glebe Road, 8<sup>th</sup> Floor  
Arlington, VA 22202

(check one)



Applicant or Patentee



Assignee of record of the entire  
interest. Statement under 37 C.F.R. §  
3.73(b) is enclosed. (Form  
PTO/SB/96)



Attorney or Agent of record

29,009

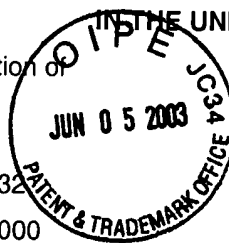
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NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.\*

☒ \*Total of 1 forms are submitted.

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS: SEND TO: Assistant Commissioner of Patents, Box CN, Washington, DC 20231.

745269



UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

Atty Dkt. 3525-71

C# M#

INGHARDT et al

Group Art Unit: 1626

Serial No. 09/509,032

Examiner: Saeed, K.A.

Filed: March 21, 2000

Date: June 5, 2003

Title: NEW AMIDINO DERIVATIVES AND THEIR USE AS THROMBIN INHIBITORS

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

**RESPONSE/AMENDMENT/LETTER**

This is a response/amendment/letter in the above-identified application and includes an attachment which is hereby incorporated by reference and the signature below serves as the signature to the attachment in the absence of any other signature thereon.

☒ **Correspondence Address Indication Form Attached.**

**Fees are attached as calculated below:**

Total effective claims after amendment 0 minus highest number  
previously paid for 20 (at least 20) = 0 x \$ 18.00 \$ 0.00

Independent claims after amendment 0 minus highest number  
previously paid for 3 (at least 3) = 0 x \$ 84.00 \$ 0.00

If proper multiple dependent claims now added for first time, add \$280.00 (ignore improper) \$ 0.00

Petition is hereby made to extend the current due date so as to cover the filing date of this  
paper and attachment(s) (\$110.00/1 month; \$410.00/2 months; \$930.00/3 months) \$ 0.00

Terminal disclaimer enclosed, add \$ 110.00 \$ 0.00

☐ First/second submission after Final Rejection pursuant to 37 CFR 1.129(a) (\$750.00) \$ 0.00  
☐ Please enter the previously unentered , filed  
☐ Submission attached

**Subtotal \$ 0.00**

If "small entity," then enter half (1/2) of subtotal and subtract -\$ 0.00  
☐ Applicant claims "small entity" status. ☐ Statement filed herewith

Rule 56 Information Disclosure Statement Filing Fee (\$180.00) \$ 0.00

Assignment Recording Fee (\$40.00) \$ 0.00

Other: 0.00

**TOTAL FEE ENCLOSED \$ 0.00**

The Commissioner is hereby authorized to charge any deficiency, or credit any overpayment, in the fee(s) filed, or asserted to be filed, or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Account No. 14-1140. A duplicate copy of this sheet is attached.

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NIXON & VANDERHYE P.C.  
By Atty: Leonard C. Mitchard, Reg. No. 29,009

Signature: \_\_\_\_\_



**UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of

INGHARDT et al

Atty. Ref.: 3525-71

Serial No. 09/509,032

Group: 1626

Filed: March 21, 2000

Examiner: Saeed, K.A.

For: NEW AMIDINO DERIVATIVES AND THEIR USE AS THROMBIN INHIBITORS

\* \* \* \* \*

June 5, 2003

Assistant Commissioner for Patents  
Washington, DC 20231

**REQUEST FOR RECONSIDERATION**

Sir:

This is in response to the Official Action mailed March 10, 2003.

Reconsideration is respectfully requested.

In the first Official Action in this case, mailed February 2, 2003, the Examiner made a restriction requirement which identified Groups I-VIII, and required the applicants to elect one of those groups. In response, the applicants elected Group IV, and traversed the requirement.

In a second action, the Examiner set forth at page 3 of the action a "generic concept of the elected subject matter". However, this "generic concept" was significantly narrower in scope than the elected Group IV. Following telephone conferences with the Examiner regarding this "generic concept", the Examiner required the applicants, by telephone, to elect a single disclosed species. In response, the

applicants elected the compound of Example 1, and requested the Examiner to vacate the second action. As reflected in the Interview Summary Record dated November 28, 2002, the Examiner acknowledged the election of Example 1 and agreed that the action of Paper No. 10 would be vacated.

In a third action, the Examiner vacated the second action and again acknowledged the applicants' election of the species of Example 1. However, instead of following the established USPTO examining practice following an election of species of searching to ascertain if prior art exists with respect to the elected species and, if none is found, searching for other species until art is developed and, if no art is ultimately found, allowing the genus, the Examiner defined a further "generic concept" which is **narrower** than that set forth in the second (vacated) action.

The examining procedure adopted in this case is believed to be improper, in that it is contrary to the established examination practice with respect to election of species. Thus, when an applicant has elected a species in response to an election of species requirement, the Examiner proceeds with searching the elected species and, if no art is found, the search is extended to other subject matter until art is ultimately developed, and, if no art is ultimately developed, the genus is allowed covering a reasonable number of species (MPEP 809.02). This procedure has clearly not been followed in this case. Rather, in response to the applicants' election of the species of Example 1, the Examiner has defined another "group" which is much narrower than the elected Group IV, without conducting any searching of the elected species. The "generic concept" proposed by the Examiner excludes, for example, compounds comprising a heteroatom in the right-hand-ring of the structural fragment IIa (see, for example, Examples 4, 6, 7,

8 and 9). Ample description is provided in the specification as filed in relation to how compounds with heteroatoms in the right-hand-ring may be obtained (see the general description of synthesis provided at pages 21 to 42). In this respect, it is submitted that the applicants are entitled to obtain protection by way of this case (bearing in mind the previous restriction requirement and election of Group IV) to compounds in which  $X_1$  represents not only  $C_{2-4}$  alkylene, but also  $C_{2-3}$  alkylene interrupted by Z, -Z-A<sup>3</sup> - and -A<sup>3</sup>-Z- **at least** (if not all of the values provided for  $X_1$ ).

It is also noted that this application is an ex-PCT application. The PCT states at Article 27 that:

"No national law shall require compliance with requirements relating to the form or contents of the international application different from or additional to those which are provided for in this Treaty and the Regulations".

An International Search Report was drawn up by the Swedish Patent Office as International Searching Authority, in which the entire subject matter as **originally** claimed across the entire claim scope was searched. It is not understood why the applicants are now required to restrict their claimed invention to a significantly narrower "generic concept" as defined by the Examiner. The Examiner has simply proposed a very narrow scope of claim, without citation to any authority whatsoever in support of this action.

Based on the above it is believed that the currently outstanding action should be vacated and that the Examiner should undertake a search of the elected species of Example 1, in accordance with established practice. Such action is respectfully requested.

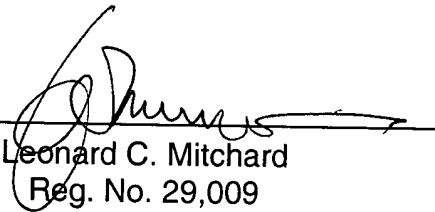
An IDS was filed on October 31, 2001. The Examiner is requested to acknowledge receipt of that IDS in the next paper to issue in this case.

Favorable action on this application is awaited.

Respectfully submitted,

**NIXON & VANDERHYE P.C.**

By: \_\_\_\_\_

  
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